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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/685,338	07/23/96	WANG L	S63.2-5902

QM31/0904

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EXAMINER	
RODRIQUEZ,C	
ART UNIT	**PAPER NUMBER**
3734	

DATE MAILED: 09/04/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary	Application No. 08/685,338	Applicant(s) Wang et al
	Examiner CAR	Group Art Unit 3734

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 8/21/98, 6/5/98.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 11-17, 35-47 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 11-17, 35-47 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 11/12

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al(5,500,180).

Anderson et al. discloses a thermoplastic polymer material balloon, where the thermoplastic polymer material is a block copolymer material.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 12-17, 35-42, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al(5,500,180).

Anderson et al. discloses the invention substantially as claimed. However, Anderson et al. does not disclose all the different variations of inflation pressure and diameter as claimed by Applicant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Anderson et al. by providing all the different variations of inflation pressure and diameter to the balloon as an obvious design choice by varying and controlling the specifications in the process of making the balloon.

5. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. in view of Kaneko et al(5,344,400).

Anderson et al. discloses the invention substantially as claimed. However, Anderson et al. does not disclose the balloon formed from at least two concentric layers of different thermoplastic polymers.

Kaneko et al. teaches a balloon having at least two concentric layers of different thermoplastic polymers for the purpose of stability and flexibility. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Anderson et al. by providing the at least two concentric layers of different thermoplastic polymers as shown by Kaneko et al. in order to improve the stability and flexibility of the balloon.

6. Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. in view of Cohen et al(5, 167,239).

Anderson et al. discloses the invention substantially as claimed. However, Anderson et al. does not disclose a method of treating a gastrointestinal lesion having the steps as claimed by Applicant.

Cohen et al. teaches an anchorable guidewire for treating a gastrointestinal lesion having the steps as claimed by Applicant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the guidewire of Cohen et al. with the Anderson's et al.'s catheter and treat a gastrointestinal lesion using the steps taught by Cohen et al. where substituting one device for the other would have been obvious depending on Applicant's intention.

Response to Arguments

7. Applicant's arguments filed June 5, 1998 and August 21, 1998 have been fully considered but they are not persuasive.

In response to Applicant's arguments that the shrinking process used in the invention is quite different from the heat set technique used in the Anderson et al. reference, the Examiner direct Applicant's attention to the M.P.E.P 2113 and 2173.05(p), where clearly set forth that a "Product by Process Claims" are not limited to the manipulations of the recited steps, but only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

Therefore, the Anderson et al. reference discloses the elements as set forth in the rejection above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is (703) 308-2194. The examiner can normally be reached on Monday-Friday from 6:30am to 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on (703) 308-1344. The fax phone number for this Group is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

9/3/98

Cris L. Rodriguez
September 3, 1998

CORRINE M. MCDERMOTT
PRIMARY EXAMINER
GROUP 3300